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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,868	07/02/2002	Jacob Wohlstadter	100390-06290	1273
22852	7590	11/24/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			SINES, BRIAN J	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,868

Applicant(s)

WOHLSTADTER ET AL.

Examiner

Brian J. Sines

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/14/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 66 – 94 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 4 of Liljestrand et al. (U.S. Patent No. 6,200,531 B1) (hereinafter “Liljestrand”) in view of Ghaed et al. (U.S. Pat. No. 5,466,416 A) (hereinafter “Ghaed”).

Regarding claims 66, 72, 87 and 89 of the instant application, with respect to claim 1 of Liljestrand, Liljestrand recites an apparatus for conducting electrochemiluminescence (ECL) measurements, wherein the apparatus is comprising:

a cell having at least one cell wall which includes a transparent portion adjacent to an ECL chamber defined within said cell;

a working electrode abutting said ECL chamber and in optical registration with said transparent portion;

a counter electrode abutting said ECL chamber; and

an electrically-shielded window adjacent to and in optical registration with said transparent portion.

Liljestrand does not specifically teach a heater that is thermally coupled or in thermal contact with the working electrode for adjusting the operating temperature of the working electrode. Liljestrand does not specifically teach a heater that is thermally coupled or in thermal contact with at least one surface of the chamber for adjusting the operating temperature of the chamber, and thereby the operating temperature of the working electrode. Ghaed does teach that the electrochemiluminescence process is substantially sensitive to the temperature of the sample under test (see col. 6, lines 38 – 49). Ghaed does teach the use of a fluid handling system that has a fluid heater system (see col. 6, lines 49 – 61). In addition, Liljestrand does teach that the electrochemiluminescence process occurs at the working electrode 140 site when testing assay samples (see, e.g., 14, lines 41 – 64). Hence, a person of ordinary skill in the art would have recognized the suitability of using a heating device to control the temperature of the working electrode test site in the disclosed device (see MPEP § 2144.07). Furthermore, a person of ordinary skill in the art would accordingly have had a reasonable expectation for success in incorporating the use of a heating element for effectively inducing and controlling the electrochemiluminescence test process at a working electrode test site in the disclosed apparatus (see MPEP § 2143.02). Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the use of a heater associated with either the working electrode or surface of

Art Unit: 1743

the chamber proximal to the working electrode as claimed to facilitate effecting heating and temperature control for the disclosed device.

Regarding claims 67, 75, 76, 78 and 85, Liljestrand teaches that the heater is coupled to a temperature controller and sensor (see col. 17, line 60 – col. 18, line 5). Closed loop control methodologies are very well known in the art (see MPEP § 2144.03). Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate an associated temperature sensor as claimed to facilitate effective temperature control for the disclosed device. In addition, the various recited temperature sensors are very well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the use of these sensors with the disclosed device for facilitating effective temperature control.

Claims 68 – 70 and 79 – 84 are considered statements of intended use. These additional claims recite no further structural limitations for the claimed apparatus. The prior teaches all of the positively recited structure of the claimed device. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the prior art device is considered capable of operating in the intended manner. Apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. The manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim (see MPEP § 2114).

Regarding claim 71, Liljestrand teaches that heater 216, is thermally coupled to an input fluid in the chamber of the device for temperature control (see col. 17, line 60 – col. 18, line 5).

Regarding claims 73, 74 and 85, Ghaed teaches the use of Peltier devices and resistive foil heaters for providing temperature control (see col. 16, lines 17 – 30). Therefore, it would

Art Unit: 1743

have been obvious to a person of ordinary skill in the art to incorporate the use of these heating elements with the disclosed device for facilitating effective temperature control. In addition, resistive thin film or foil heating elements are well known in the art to have a thickness of 1 inch or less.

Regarding claim 77, Liljestrand teaches that the sensors may be incorporated with, or an integral part, of the heater (see col. 18, lines 1 – 3). The use of a one-piece, integrated construction instead of the structure disclosed or taught in the prior art would have been within the ambit of a person of ordinary skill in the art (see MPEP § 2144.04). Therefore, it would have been obvious to a person of ordinary skill in the art to provide a temperature sensor that is an integral component of the heater.

Regarding claims 86 and 90, Liljestrand teaches the incorporation of a photodetector, such as a photodiode (see, e.g., col. 5, lines 32 – 35; col. 6, lines 53 – 65). Claims 2 – 4 of Liljestrand recites the further incorporation of a photodetector with the apparatus. Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the use of a photodetector with the disclosed apparatus as claimed for facilitating effective ECL measurement detection.

Regarding claim 88, Liljestrand teaches the incorporation of a magnetic field generating device (e.g., magnet 146) (see figure 3B; col. 13, lines 46 – 67).

Regarding claim 89, Liljestrand teaches the incorporation of an electrically-shielded window (see, e.g., col. 5, lines 49 – 57).

Regarding claims 91 – 93, Liljestrand teaches the incorporation of a light source that is also capable of avoiding the detection of infrared radiation (see, e.g., col. 8, lines 22 – 34; col. 10, lines 51 – 63).

Regarding claim 94, Liljestrand teaches the incorporation of an optical filter configuration (see, e.g., col. 11, lines 8 – 26).

Response to Arguments

Applicant's arguments filed 9/14/2006 have been fully considered but they are not persuasive. The Applicant alleges that the nonstatutory obviousness-type double patenting rejection in office action mailed 6/14/2006 is inappropriate for the present claims. In particular, the Applicant alleges that only the claims of the instant application and the patent claims can be compared, without referring to the disclosure of the cited patent (see pages 3 and 4 of Applicant's arguments section). As shown above in the double-patenting rejection, the claims of the instant application and the cited patent are compared and differences noted. Furthermore, the specification of the prior patent can indeed be relied upon in a nonstatutory obviousness-type double patenting rejection. The Applicant's discussion of *General Foods* is incomplete. The MPEP further states that "[t]his does not mean that one is precluded from all use of the patent disclosure." The MPEP clearly indicates that in an obviousness-type double patenting rejection, the specification of the patent may be used as prior art in determining if the present application claims an obvious variation of an invention claimed in the cited prior patent. "[T]hose portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent[.]" In addition, "this use of the disclosure is not

Art Unit: 1743

contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined.” (see MPEP § 804, page 800 – 22; Rev. 5, Aug. 2006). Hence, as indicated in the rejection above, the claimed apparatus of the instant application is an obvious variation of the claimed apparatus of the cited patent. Therefore, this rejection indeed is considered proper and maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

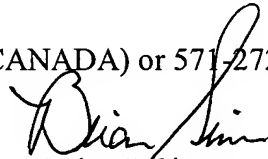
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

Art Unit: 1743

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brian J. Sines
Primary Examiner
Art Unit 1743